

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of ) **MAIL STOP AMENDMENT**  
Kotaro Kaneko )  
Application No.: 10/647,383 ) Group Art Unit: 2135  
Filed: August 26, 2003 ) Examiner: APRIL YING SHAN  
For: CONTROLLING COMPUTER ) Confirmation No.: 2047  
PROGRAM, CONTROLLING )  
APPARATUS, AND CONTROLLING )  
METHOD FOR DETECTING )  
INFECTION BY COMPUTER VIRUS )

**RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

A Notice of Non-Compliant Amendment was issued in the above-identified application on March 26, 2009. The Notice is improper and was issued in error.

The Notice indicates that the Request for Reconsideration filed on December 29, 2008 was non-compliant, because a complete listing of the claims was not supplied with the Request for Reconsideration. Applicant respectfully submits that this assertion appears to be based on a misunderstanding of the applicable rules of practice.

37 C.F.R. 1.121(c) provides that "[e]ach amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application." (emphasis added) Accordingly, as indicated in the emphasized portion of 37 C.F.R. 1.121(c), a prerequisite to the requirement to submit a complete listing of the claims is that at least one claim must be amended, added or cancelled in a communication filed in the Office. MPEP 714(II)(C)(C) further provides that "[t]he text of all pending claims under examination and withdrawn claims must be submitted each time any claim is amended." (emphasis added) Thus, MPEP 714(II)(C)(C) is further evidence that a

complete listing of the claims must be provided only when one or more claims is amended, cancelled or added in the application.

Despite these rules, the Office asserted that the Request for Reconsideration was non-compliant, because a complete listing of the claims was not supplied therewith. However, the Request for Reconsideration did not present any claim amendments. Therefore, in full compliance with all applicable rules of practice, a complete listing of the claims was not presented with the Request for Reconsideration, since the Request for Reconsideration was not an "amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim" (see 37 C.F.R. 1.121(c)), nor a document in which "any claim is amended" (see MPEP 714(II)(C)(C)).

Therefore, since the Request for Reconsideration did not present any claim amendments, a complete listing of the claims was unnecessary and certainly not required under 37 C.F.R. 1.121(c).

Upon receipt of the Notice, Applicant's undersigned representative contacted the Examiner on March 27, 2009 by telephone to discuss the impropriety of the Notice. The Examiner informed Applicant's representative that the requirement in 37 C.F.R. 41.37 to submit a copy of a claims appendix in an Appeal Brief is justification for the belief that a complete listing of claims must be submitted even in a response to an Office Action that does not include any claim amendments. However, there is no analogous application of 37 C.F.R. 41.37(c)(1)(viii) to the submission of responses to Office Actions. 37 C.F.R. 41.37(c)(1)(viii) explicitly requires that an Appeal Brief include an appendix containing a copy of the claims involved in the appeal, i.e., it is limited to only those claims to be considered by the Board. On the contrary, 37 C.F.R. 1.121(c) pertains to active examination of an application, and requires a complete listing of the claims only if one or more claims is amended, cancelled or added. These two rules are directed to entirely different aspects of examination, and the requirements of one are not applicable to the other.

In response to the telephone interview with the Examiner on March 27, 2009, the Examiner then issued an Interview Summary record indicating that "Applicant will submit a complete list of claims with proper status identifiers." Applicant's representative respectfully submits that this characterization of the telephone

interview is not entirely correct. Applicant's representative indicated that a complete listing of the claims would be submitted if required under the rules of practice.

In view of the foregoing reasons, Applicant respectfully submits that the issuance of the Notice was improper and unsupported by any applicable rule of practice. Therefore, a complete listing of the claims is not submitted since 37 C.F.R. 1.121(c) does not require submission of a complete listing of the claims for a communication in which no claim was amended, cancelled or added.

Accordingly, Applicant respectfully requests withdrawal of the Notice in view of its impropriety. If the Examiner requires submission of a complete listing of the claims in contradistinction of 37 C.F.R. 1.121(c), the Examiner is respectfully requested to provide authoritative support therefor.

If the Office requires any further submission before the Request for Reconsideration can be considered, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: April 27, 2009

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